

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re Patent Application of

Gregory D. May et al.

Group Art Unit: 1638

Application No.: 09/892,635

Examiner: ASHWIN D MEHTA

Filing Date: June 28, 2001

Confirmation No.: 4469

Title: DNA REGULATORY ELEMENTS ASSOCIATED WITH FRUIT DEVELOPMENT

AMENDMENT/REPLY TRANSMITTAL LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed is a reply for the above-identified patent application.

A Petition for Extension of Time is also enclosed.
 Terminal Disclaimer(s) and the \$55.00 (2814) \$110.00 (1814) fee per Disclaimer due under 37 C.F.R. § 1.20(d) are also enclosed.
 Also enclosed is/are _____

Small entity status is hereby claimed.
 Applicant(s) requests continued examination under 37 C.F.R. § 1.114 and enclose the \$385.00 (2801) \$770.00 (1801) fee due under 37 C.F.R. § 1.17(e).
 Applicant(s) requests that any previously unentered after final amendments not be entered. Continued examination is requested based on the enclosed documents identified above.
 Applicant(s) previously submitted _____

on _____, for which continued examination is requested.
 Applicant(s) requests suspension of action by the Office until at least _____, which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.
 A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (1809/2809) is also enclosed.

No additional claim fee is required.
 An additional claim fee is required, and is calculated as shown below.

AMENDED CLAIMS					
	No. of Claims	Highest No. of Claims Previously Paid For	Extra Claims	Rate	Additional Fee
Total Claims	28	MINUS 28 =	0	x \$18.00 (1202) =	\$ 0.00
Independent Claims	2	MINUS 3 =	0	x \$86.00 (1201) =	\$ 0.00
If Amendment adds multiple dependent claims, add \$290.00 (1203)					
Total Claim Amendment Fee					\$ 0.00
<input type="checkbox"/> Small Entity Status claimed - subtract 50% of Total Claim Amendment Fee					\$ 0.00
TOTAL ADDITIONAL CLAIM FEE DUE FOR THIS AMENDMENT					\$ 0.00

A check in the amount of _____ is enclosed for the fee due.
 Charge _____ to Deposit Account No. 02-4800.
 Charge _____ to credit card. Form PTO-2038 is attached.

The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

Date: August 27, 2004

By 
Malcolm K. McGowan, Ph.D.
Registration No. 39,300



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

re Patent Application of
Gregory D. May et al.
Application No.: 09/892,635
Filed: June 28, 2001
For: DNA REGULATORY ELEMENTS
ASSOCIATED WITH FRUIT
DEVELOPMENT

Mail Stop AMENDMENT

Group Art Unit: 1638

Examiner: ASHWIN D MEHTA

Confirmation No.: 4469

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In complete response to the Office Action dated August 4, 2004, requiring restriction under 35 USC 121, Applicants hereby elect, albeit with traverse, the claims of Group I, claims 17-31 and 34-44.

According to MPEP 803, “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” The Examiner has divided the pending claims in the present application into two groups. Group I includes claims 17-31 and 34-44, drawn to “isolated and purified banana DNA regulatory element; a chimeric gene operably linked to said regulatory element; a plant genome, plant cell, or plant comprising said chimeric gene; a method for the expression of heterologous protein in fruit...; [and] a fruit produced by said method.”

Official Action at 2. Group II includes claims 32 and 33, “drawn to a protein.” Id. The protein in question is the protein encoded by the DNA of the claims of Group I. Applicants respectfully submit that a complete search for both the claims of Group I

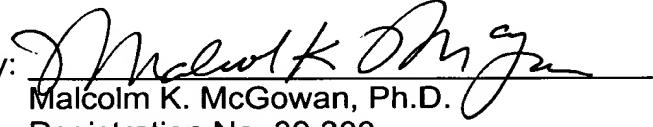
and Group II would necessarily overlap; as a result, it would not pose a serious burden on the Examiner to examine the claims of both groups on the merits in this application. Accordingly, withdrawal of the restriction requirement, and examination of all of the claims of record in this application is respectfully requested.

In the event that there are any questions concerning this Response, or the application in general, the Examiner is respectfully urged to telephone Applicants' undersigned representative so that prosecution of the application may be expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: August 27, 2004

By: 
Malcolm K. McGowan, Ph.D.
Registration No. 39,300

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620